



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,042	02/19/2002	Walter Messier	GENO200.1/CIP	5992

25871 7590 05/14/2004
SWANSON & BRATSCHUN L.L.C.
1745 SHEA CENTER DRIVE
SUITE 330
HIGHLANDS RANCH, CO 80129

EXAMINER

HORLICK, KENNETH R

ART UNIT PAPER NUMBER

1637

DATE MAILED: 05/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/079,042	Applicant(s) MESSIER, WALTER	
	Examiner Kenneth R Horlick	Art Unit 1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-78 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-78 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 1637

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 1. Claims 1-30 and 37-44, drawn to methods of identifying a polynucleotide, classified in class 436, subclass 94.
 2. Claims 31-36, 45-50, and 53, drawn to EG307 polynucleotides and related products, classified in class 536, subclass 23.6.
 3. Claims 51, 52, and 54-56, drawn to methods of providing increased or controllable yield in a plant, classified in class 435, subclass 468.
 4. Claims 57-65, drawn to methods of isolating yield-related genes using EG307 nucleic acid sequences, classified in class 435, subclass 6.
 5. Claim 66, drawn to a polynucleotide of various SEQ ID NOs, classified in class 536, subclass 23.6.
 6. Claim 67, drawn to a polynucleotide of various SEQ ID NOs, classified in class 536, subclass 23.6.
 7. Claim 68, drawn to a polynucleotide of various SEQ ID NOs, classified in class 536, subclass 23.6.
 8. Claim 69, drawn to a polynucleotide of various SEQ ID NOs, classified in class 536, subclass 23.6.
 9. Claim 70, drawn to a polynucleotide of various SEQ ID NOs, classified in class 536, subclass 23.6.
 10. Claim 71, drawn to a polynucleotide of various SEQ ID NOs, classified in class 536, subclass 23.6.

Art Unit: 1637

11. Claim 72, drawn to a polypeptide of various SEQ ID NOs, classified in class 530, subclass 370.
12. Claim 73, drawn to a polypeptide of various SEQ ID NOs, classified in class 530, subclass 370.
13. Claim 74, drawn to a polypeptide of various SEQ ID NOs, classified in class 530, subclass 370.
14. Claim 75, drawn to a polypeptide of various SEQ ID NOs, classified in class 530, subclass 370.
15. Claim 76, drawn to a polypeptide of various SEQ ID NOs, classified in class 530, subclass 370.
16. Claim 77, drawn to a polypeptide of various SEQ ID NOs, classified in class 530, subclass 370.
17. Claim 78, drawn to a polypeptide of various SEQ ID NOs, classified in class 530, subclass 370.

The inventions are distinct, each from the other because of the following reasons:

A) Inventions 1, 3, and 4 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions relate to methods with different steps and parameters which have different functions.

B) Inventions 5-17 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions correspond to different nucleic acids or polypeptides encoded by such nucleic acids. Each different nucleic acid and polypeptide has its own unique function, and nucleic acids and polypeptides have completely different chemical structures and functions.

C) Inventions (2, 5-17) and 3 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process, such as in hybridization assays.

D) Inventions (2, 5-17) and (1,4) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions relate to products and methods not using or making said products.

E) Inventions 2 and 5-17 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions (polynucleotides/polypeptides) have

Art Unit: 1637

different functions – expression in plant cells versus hybridization detection, for example.

Sequence Election Requirement Applicable to Groups 5-17

In addition, each Group detailed above reads on patentably distinct Groups drawn to multiple SEQ ID Numbers. The sequences are patentably distinct because they are unrelated sequences, and a further restriction is applied to each Group. For an elected Group drawn to amino acid sequences, the Applicants must further elect a single amino acid sequence. For an elected Group drawn to nucleotide sequences, the Applicants must further elect a single nucleic acid sequence (See MPEP 803.04).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, or because the search required for any of Groups 2 and 5-17 is not required for any one of the other Groups, restriction for examination purposes as indicated is proper.

2. A telephone call was made to Darla Yoerg on 04/28/04 to request an oral election to the above restriction requirement, but did not result in an election being made.

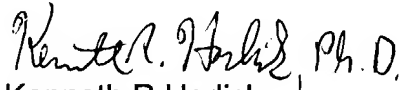
Art Unit: 1637

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R Horlick whose telephone number is 571-272-0784. The examiner can normally be reached on Monday-Thursday 6:30AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kenneth R Horlick
Primary Examiner
Art Unit 1637

04/29/04